

REMARKS

Status of the Claims

Claims 1 and 4-10 are currently pending in the application. Claims 1-3, 9 and 10 stand rejected. Claims 4-8 are withdrawn as being drawn to a non-elected invention. Claims 1, 4, 7 and 10 have been amended. Claims 2 and 3 have been cancelled. All amendments and cancellations are made without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendment to claim 1 is supported by at least claim 3 (now cancelled). Amendment of claim 10 is supported by the specification at, for instance, page 7, lines 5-8. Claims 4 and 7 are amended to update their dependency in light of the cancelled claims. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 10 stands rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See, Office Action of August 8, 2008, at page 2, hereinafter, "Office Action"). Applicants traverse the rejection.

The Examiner states that claim 10 is unclear because it is not certain whether the claimed mutant has the function of degrading polyurethane bonds.

Although Applicants do not agree that claim 10 is indefinite, to expedite prosecution, claim 10 has been amended to recite, in part, "which has the ability to degrade polyurethane bonds." Applicants believe this amendment addresses the Examiner's basis for rejection by specifying that the claimed mutant has the function of degrading polyurethane bonds.

Reconsideration and withdrawal of the indefiniteness rejection of claim 10 are respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

Claims 1, 2 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Ohshiro et al., *Appl. Microbiol. Biotechnol.*, 48:546-548, 1997 (hereinafter, "Ohshiro et al.") in view of ATCC Catalog. (See, Office Action, at pages 3-4). Claim 2 has been cancelled, thereby obviating the rejection of claim 2. Applicants traverse the rejection as to the remaining claims.

In response to Applicants' arguments of March 26, 2008, the Examiner responds that the present claims broadly encompass any *Rhodococcus* or *R. equi*. The Examiner does not believe Applicants' arguments that the strains disclosed in Ohshiro et al. cannot be reclassified as *Rhodococcus*.

However, the Examiner's statements directly contradict the primary evidence submitted in the prior response. The Examiner appears to not give any weight to the previously submitted evidence. That is, by showing that none of the microorganisms in the Ohshiro et al. belong to *Rhodococcus*, Applicants have adequately shifted the burden onto the Examiner that the cited reference does not disclose or suggest Applicants' invention.

Further, although Applicants do not agree that claim 1 is anticipated by the cited references, to expedite prosecution, claim 1 has been amended to recite the limitations of non-anticipated and non-obvious dependent claim 3. It is noted that the Examiner states at page 5 of

the Office Action that claim 3 is objected to for depending on a rejected base claim, but would otherwise be allowable if re-written in independent form.

Therefore, Applicants believe that claim 1, at least as amended, is neither anticipated, nor obvious, in light of the cited references because claim 1, at least as amended, recites limitations that are neither disclosed nor suggested by the combined disclosures of the cited references.

Dependent claim 9 is not anticipated as, *inter alia*, depending from a non-anticipated base claim, claim 1.

Reconsideration and withdrawal of the anticipation rejection of claims 1 and 9 are respectfully requested.

Request for Rejoinder

It is believed that at least claims 1, 9 and 10 are in condition for allowance, all outstanding rejections having been addressed, above. Therefore, there being no further issues precluding allowance, Applicants respectfully request rejoinder of method claims 4-8 as allowed under the Rules. That is, where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims, i.e. claims 4-8, will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Thus, the process claims must be rejoined and fully examined for patentability according to the provisions of 37 C.F.R. § 1.104.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Thomas J. Siepmann, Ph.D., Reg. No. 57,374, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

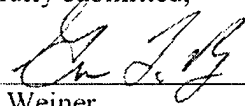
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated:

NOV 05 2008

Respectfully submitted,

By

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